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- In the Office Action dated April 2, 2002, the Examiner
- 3 rejected claims 3-14, 41-46, and 48-49 under 35 U.S.C. § 103.
- 4 Applicant firmly believes the above amendments and the following
- 5 remarks will convince the Examiner that the rejection of the
- 6 pending claims should be reconsidered and withdrawn. In short,
- 7 applicant respectfully submits that the Examiner's understanding
- .8 of the present invention as well as his application of the prior
- 9 art are misplaced.
- 10 With respect to the Examiner's objection to the
- 11 specification/drawings, applicant has amended the specification
- and wishes to thank the Examiner for calling these issues to his
- 13 attention.
- 14 Applicant respectfully submits that the claims, as amended,
- are not rendered obvious by the cited references. On further
- reflection, we are confident that the Examiner will recognize
- that the rejections based on Hyodo U.S. Patent No. 5,937,390
- 18 (Hyodo) in view of Rondeau U.S. Patent No. 5,850,433 (Rondeau)
- 19 could only be the result of a hindsight reconstruction of the
- 20 applicant's invention.
- Initially, the Examiner rejected claims 3-14, 41-46 and 48-
- 22 49 as being obvious over Hyodo in view of Rondeau. In the



- opinion of the Examiner, Hyodo teaches a system capable of, inter
- 2 alia, "receiving a first connection from a user via the Internet
- 3 in response to advertisement; initiating a second voice
- 4 connection with the advertiser via telephone; and coupling the
- 5 first and second connections" (citing col. 3, lines 13-26 and
- 6 col. 4, lines 12-31). Applicant disagrees. Specifically, Hyodo
- 7 does not teach a system (i.e., the same system as that providing
- 8 the advertising) capable of receiving a voice connection from the
- 9 user and initiating a voice connection with the advertiser,
- whereby the two voice connections are then coupled together by
- the same system. Applicant submits that Hyodo merely discloses
- an on-line advertising system in which a user is provided with a
- toll free number to call an advertiser via telephone. This is
- 14 not the claimed invention. Rather, the only "second connection"
- even remotely suggested by Hyodo is when the "user calls the
- 16 toll-free number in the advertisement and orders the product that
- 17 he/she likes" (see Hyodo col. 3, lns. 12-19).
- This differs from the applicant's claimed invention in three
- 19 distinct ways. First, this is not a second voice connection, but
- 20 rather the first (and only) voice connection in the Hyodo system.
- 21 Second, and more importantly, Hyodo does not teach that the
- 22 system initiates any call. Third, Hyodo cannot possibly teach.



- that the system couples a first voice connection with a second
- 2 voice connection, given that there is only one voice connection
- 3 -- which is the conventional telephone call initiated by the
- 4 user. Moreover, Hyodo goes on to teach that in order to respond
- 5 to an advertisement, a user must call the toll free number using
- 6 a telephone. This is described at column 4, lines 20-21, and is
- 7 shown in Fig. 3, item 7: "To Order, Please Call 0120-XXXXXXX."
- 8 Clearly, this is very different from the applicant's claimed
- 9 invention which receives a first voice connection from a user via
- 10 telephone in response to an advertisement, initiates a second
- ll voice connection with an advertiser via the telephone or
- 12 Internet, and then couples the first voice connection with said
- 13 second voice connection enabling a voice conversation between the
- 14 user and advertiser -- Hyodo does not address the problem of
- responding to an advertisement in this manner.
- 16 Furthermore, while the Examiner correctly notes that Hyodo
- 17 fails to teach that an Internet connection may be a voice
- 18 connection, applicant disagrees that this would have been obvious
- 19 to one of ordinary skill in the art at the time of the invention.
- 20 Nothing in either Hyodo or Rondeau suggest anything to the
- 21 contrary. In fact, Hyodo even teaches away from the claimed
- 22 invention. For instance, Hyodo specifically teaches a system



which requires a user to independently (i.e., outside the 1 disclosed system) place a telephone call if the user wishes to 2 contact an advertiser. Nonetheless, even if such a combination 3 were proper, this still would not teach all of the elements of the claimed invention, as described above. That is, such a 5 combination does not teach a method or system for providing an 6 enhanced computer based advertising system which receives a first 7 8 voice connection from a user via telephone in response to an advertisement, initiates a second voice connection with an 9 advertiser via the telephone or Internet, and then couples the 10 first voice connection with said second voice connection enabling 11 a voice conversation between the user and advertiser. Thus, even 12 if the combination of references as suggested by the Examiner 13 were proper, which applicant believes is not, such combination 14 would still not teach each and every element of the claimed 15 16 invention. Further, the applicant respectfully points out that, 17 standing on their own, the cited references provide no 18 19 justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of 20 the prior art to produce the claimed invention, absent some 21 teaching or suggestion supporting the combination. Under section



- 1 103, teachings of references can be combined only if there is
- 2 some suggestion or incentive to do so." ACS Hospital Systems
- 3 Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q.
- 4 929, 933 (Fed. Cir. 1984) (emphasis in original).
- 5 The cited references provide no such suggestion or incentive
- for the combination suggested by the Examiner. Therefore, the
- 7 obviousness rejection could only be the result of a hindsight
- 8 view with the benefit of the applicant's specification. However,

"To draw on hindsight knowledge of the patented 9 invention, when the prior art does not contain or 10 suggest that knowledge, is to use the invention as a 11 template for its own reconstruction -- an illogical and 12 13 inappropriate process by which to determine patentability. The invention must be viewed not after 14 the blueprint has been drawn by the inventor, but as it 15 would have been perceived in the state of the art that 16 existed at the time the invention was made."(citations 17 omitted) Sesonics v. Aerosonic Corp., 38 U.S.P.Q. 2d. 18 19 1551, 1554 (1996).

In addition, the combination or expansion advanced by the
Examiner is not legally proper -- on reconsideration the Examiner
will undoubtedly recognize that such a position is merely an
"obvious to try" argument. The disclosure in the specification
and claims of Hyodo and Rondeau do not reveal any functional or
design choices that could possibly include that of the
applicant's invention. In the present case, the Examiner

provides no support or suggestion from the references themselves



as to why the proposed combination is obvious. Rather, the fact 1 that the present invention produces an enhancement or advantage 2 3 (i.e., convenience of use) further demonstrates the improvement applicant has found, establishing that the combination produces 4 new and unexpected results, and hence would NOT have been obvious 5 at the time of the invention. Moreover, Hyodo teaches away from 6 such a combination in that its system specifically provides for a 7 user to place an external telephone call if the user wishes to 8 contact an advertiser. Significant modification of the system 9 would be necessary to modify a system according to Hyodo as 10 suggested by the Examiner. Accordingly, it was not obvious to 11 combine Hyodo and Rondeau to arrive at the present invention. At 12 best it might be obvious to try such a combination. Of course, 13 "obvious to try" is not the standard for obviousness under 35 14 U.S.C. §103. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 15 U.S.P.O. 81, 91 (Fed. Cir. 1986). 16 Under the circumstances, we respectfully submit that the 17 Examiner has succumbed to the "strong temptation to rely on 18 hindsight." Orthopedic Equipment Co. v. United States, 702 F.2d 19 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983): 20 "It is wrong to use the patent in suit as a guide 21 through the maze of prior art references, combining the 22 right references in the right way so as to achieve the 23 result of the claim in suit. Monday morning quarter 24

1 2	backing is quite improper when resolving the question of non-obviousness in a court of law." <i>Id</i> .
3	Applicant submits that the only "motivation" for the Examiner's
4	expansion or combination of the references is provided by the
5	teachings of applicant's own disclosure. No such motivation is
6	provided by the references themselves.

Therefore, as is evidenced by the above amendments and remarks, the present invention, for the first time, discloses method or system for providing an enhanced computer based advertising system which receives a first voice connection from a user via telephone in response to an advertisement, initiates a second voice connection with an advertiser via the telephone or Internet, and then couples the first voice connection with said second voice connection enabling a voice conversation between the user and advertiser. A system and method such as this is neither taught nor suggested anywhere in the prior art, including Hyodo and Rondeau.

Date: August 2, 2002

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CONCLUSION

- 2 In view of the foregoing, applicant respectfully submits
- 3 that the present invention represents a patentable contribution
- to the art and the application is in condition for allowance.
- 5 Early and favorable action is accordingly solicited.

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Respectfully submitted,

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